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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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WENDEROTH, LIND & PONACK, L.L.P.				
2033 K STREET N. W.				
SUITE 800				
WASHINGTON, DC 20006-1021				
			EXAMINER	
			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/935,661

Applicant(s)

OSHIMA, KENJI

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7 and 8 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

**Claim Rejections - 35 USC § 103**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 3-5, and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Swift et al. (U.S. 4,388,434) taken in view of the evidence in Takao et al. (U.S. 6,627,696).

The rejection is adequately set forth in paragraph 3 of the office action mailed 5/26/04 and is incorporated here by reference.

**Response to Arguments**

3. Applicant's arguments filed 8/26/04 have been fully considered but they are not persuasive.

Specifically, applicant argues that Swift et al. is not a relevant reference against the present claims given that Swift et al. is drawn to lithographic ink while the present claims require ink "for ink jet printer". Applicant argues that while the examiner did not consider the phrase "for ink jet printer" as recited in the present claims, the phrase must be considered in determining the issue of patentability of the present invention over the prior art.

It is agreed that Swift et al. is drawn to lithographic ink not ink "for ink jet printer". It is the examiner's position that the recitation in the claims that the ink is suitable "for ink jet printer" is merely an intended use. Applicant's attention is drawn to MPEP 2111.02 which states

that intended use statements must be evaluated to determine whether the intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the intended use recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure is capable of performing the intended use. Given that Swift et al. disclose ink identical to that presently claimed, it is clear that the ink of Swift et al. would be capable of performing the intended use, i.e. for ink jet printer, presently claimed as required in the above cited portion of the MPEP.

However, applicant argues that there is a difference between the ink of Swift et al. and the presently claimed ink for ink jet printer in that the lithographic ink of Swift et al. has very different viscosity than ink jet ink. In light of this difference, applicant argues that the recitation of the phrase "for ink jet printer" excludes the lithographic ink of Swift et al.

However, it is noted that "the arguments of counsel cannot take the place of evidence in the record", *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the applicant regarding the ink of Swift et al. must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001".

The above is especially significant given that while Swift et al. disclose the viscosity of polymers used in the lithographic ink, there is no explicit disclosure in Swift et al. of the viscosity of the ink. Attention is drawn to examples XL, XLI, and XLII of Swift et al. that disclose inks but do not disclose the viscosity of the ink. While the inks do contain polymer possessing high viscosity, it is noted that these polymers are added to other ingredients, i.e. pigment, Magie oil, etc. It is not clear how these other ingredients would affect the viscosity of the ink. For instance, Magie oil possesses very low molecular weight (see col.7, lines 14-26) and thus, low viscosity, which would necessarily affect the viscosity of the ink. Further, the polymers set forth in the examples of Swift et al. are just a few preferred examples. The lowest molecular weight polymer found in the examples possesses weight average molecular weight of 3800. However, a fair reading of the reference as a whole discloses that the polymer may possess molecular weight as low as 1000. It is not clear what affect using such polymer would have on both the viscosity of the polymer and the viscosity of the ink.

Thus, given that there is no clear and convincing evidence, i.e. in the form of a declaration, that there is a structural difference between the claimed ink and the ink of Swift et al. or any evidence that the ink of Swift et al. would not be capable of performing the intended use, i.e. "for ink jet printer", Swift et al. remains a relevant reference against the present claims.

Applicant also argues that in Swift et al., the manganese naphthenate and cobalt naphthenate are used for a different purpose, i.e. as dryer that is catalyst for an oxygen curing of the alkyd varnish, than in the present invention. However, regardless of how the metal soap is used, given that Swift et al. disclose the use of metal soap identical to that presently claimed, it is

clear that Swift et al. meets the requirements of the present claims. The present claims only require ink comprising aliphatic hydrocarbon solvent, colorant, polymer, and metal soap. Given that Swift et al. disclose such composition, it is clear that Swift et al. meets all the requirements of the present claims.

**Allowable Subject Matter**

4. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As set forth in paragraph 4 of the office action mailed 5/26/04, claim 6 would be allowable if rewritten in independent form as described above given that the "closest" prior art Swift et al. (U.S. 4,388,434) is drawn to lithographic ink with no disclosure or suggestion of electrostatic ink jet recording apparatus comprising the ink as required in present claim 6.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

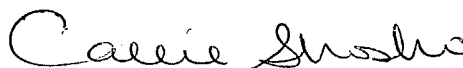
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
12/6/04